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IN THE

Supreme Court of the United States

OCTOBER TERM, 1942.

No. 612

SCHLUMBERGER WELL SURVEYING CORPORATION,

Petitioner,

vs.

HALLIBURTON OIL WELL CEMENTING COMPANY,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR CERTIORARI.

This is the ordinary patent infringement suit, brought by the petitioner in the United States District Court for the Southern District of Texas, charging respondent with infringement of the four claims of Letters Patent No. 1,819,923 [V. 3249-51]* and claim 1 of Letters Patent No. 1,913,293 [VI. 3826-9]. The Court of Appeals for the Fifth Circuit adjudged all of the claims of patent 1,819,923, and claim 1 of patent 1,913,293, invalid and

*Herein the Roman numeral indicates the Volume of the Record, followed by the page number.

adjudged non-infringement of the claims of patent 1,819,923 [XII. 5568-76; 130 F 2d 589]. There is no pretense of a conflict of decision with regard to either of these patents. This is the only decision adjudicating either of said patents. The controversy is of a private nature, between competitors in the same business. No question of public importance is involved.

In *Layne & Bowler Corp. v. Western Well Works,* 261 US 388, this Court held that a writ of certiorari will not be granted in patent litigation except in cases involving principles, the settlement of which is important to the public as distinguished from the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeals. No such situation exists here.

The petition (p. 20) represents that the inventions in controversy are of "great social and economic benefit to the public and to the petroleum industry, * * *"; that at present "Respondent is the only infringer * * *"; that "Further litigation with a resulting conflict of decision is improbable * * * at least for the duration of the war." (p. 16). The use of the processes and apparatus in controversy is manifestly not limited to the Fifth Circuit. The petroleum industry is not localized therein. A substantial percentage of all corporations engaged in the oil business are organized under the laws of Delaware and may be sued in the District of Delaware. This Court takes judicial notice of the commonly known fact that there has been and continues to be extensive development

of oil fields in the Third, Fifth, Sixth, Seventh, Ninth and Tenth Circuits. The drilling for oil in Pennsylvania, Ohio, Indiana, Michigan, Illinois, Wyoming, Kansas, Oklahoma, Texas and California is common knowledge. The very fact that the claims in issue of the respective patents have been held invalid insures the use by the public of such alleged inventions, if they have value. The mere fact that ordinary civil business endeavor is curtailed by the war effort is not a cogent or any ground for the grant of the writ of certiorari in this case. It is believed that this Court will take judicial notice of the fact that the federal government is now urging the discovery and development of new oil fields throughout the United States. No such showing is made by petitioner here, as was made in the case of *Altoona Publix Theatres, Inc. v. Tri-Ergon Corp.*, 294 US 477, wherein the therein petitioner proved that the patent owner had publicly announced it would not bring any suit in any other circuit. Indeed, petitioner had already brought suit in the Southern District of California on one of the patents in question before filing the instant suit. [III. 2325.]

The petitioner herein (pp. 2-3) presents three alleged questions, the determination of which by this Court is requested upon certiorari. These questions exist only in the imagination of petitioner's counsel, and do not exist in the case.

Question 1.—The alleged failure of the Court of Appeals to follow applicable decisions of this Court.

Petitioner predicates this question upon an alleged application of the *decision* in *Mitchell v. Tilghman,* 19 Wall. 287, and a disregard or overlooking of the later decision of this Court in *Tilghman v. Proctor,* 102 US 707, which expressly overruled *Mitchell v. Tilghman.* This first question is based upon a fallacious reading of the opinion of the Court of Appeals herein. The applicable decisions of this Court, relied upon by the Court of Appeals herein, are stated in the opinion. The interpretation of the claims of the respective patents in suit was based upon the authority of, and followed the decisions of this Court in, *Carnegie Steel Co. v. Cambria Iron Co.,* 185 US 403, 432; *Continental Paper Bag Co. v. Eastern P. B. Co.,* 210 US 405, 419; *Schriber-Schroth Co. v. Cleveland Trust Co.,* 311 US 211, 217; *Schriber-Schroth Co. v. Cleveland Trust Co.,* 305 US 47,—and not upon either *Mitchell v. Tilghman* or *Tilghman v. Proctor.*

The opinion of the Court of Appeals herein applied the well-established principle that the claim or claims of a patent measure the invention and determine what is patented; that the claims may be explained and illustrated by the description, but they cannot be enlarged by it (*Continental Paper Bag Co. v. Eastern P. B. Co.,* 210 US 405, 419); and that, as said by this Court in *General Electric Co. v. Wabash Appliance Corp.,* 304 US 364, 372:—

> "But Congress requires, for the protection of the public, that the inventor set out a definite limitation

of his patent; that condition must be satisfied before the monopoly is granted. * * *"

"* * * Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claims 'measure the invention.' * * *" (*Id.* at p. 369.)

Cf. *United Carbon Co. v. Binney & Smith Co.*, decided by this Court Dec. 7, 1942 (not officially reported; see 87 L ed Adv. Ops. 158).

The decision of the Court of Appeals is not in conflict with the well-established principles of patent law respecting the interpretation of patents for inventions. The case presents no conflict of decision and no principle, or the application of any principle, not thoroughly established and clarified by the decisions of this Court.

Question 2.—The alleged misconception by the Court of Appeals of the requirements of the patent statute, and failure to apply applicable decisions of this Court in holding that neither patent points out in the disclosure, or distinctly claims, a useful invention.

With respect to the resistivity patent, 1,819,923, the Court of Appeals analyzed the disclosure of the specification and interpreted the claims in the light of the specification, applying the well-established principle that, "The claim of a patent must always be explained by and read in connection with the specification, * * *" (*Carnegie Steel Co. v. Cambria Iron Co.,* 185 US 403, 432; Cf. *Continental Paper Bag Co. v. Eastern P. B. Co.,* 210 US 405, 419; *Schriber-Schroth Co. v. Cleveland Trust Co.,* 311 US 211, 217-18). See particularly opinion of Court of Appeals [XII. 5571-4]. The Court of Appeals found:– "The only discovery this patentee distinctly points out that he made is that rocks have specific resistivities which characterize them and can be calculated. His patent monopoly can include no more. *Schriber-Schroth Co. v. Cleveland Trust Co.,* 305 U. S. 547." [XII. 5573]. The principle thus applied and so reiterated in said *Schriber-Schroth* decision is not contrary to either the decision in *Mitchell v. Tilghman,* 19 Wall. 287, or *Tilghman v. Proctor,* 102 US 707. This Court has recognized that the principles of law set forth in said *Mitchell v. Tilghman* decision were not determined to be erroneous in *Tilghman v. Proctor.* On the contrary, this Court has several times cited the decision in *Mitchell v. Tilghman* as authority. Cf. *Holland Furniture Co. v. Perkins Glue Co.,* 277 US 245, 257; *General Elec. Co. v. Wabash Appliance Corp.,* 304 US 364, 373; *Hobbs v. Beach,* 180 US 383, 400.

The Court of Appeals followed established authority in first determining what was disclosed in and defined by the claims of the patents in suit, giving due effect to the disclosures of the specifications of the respective patents. It found that neither of the patents defined the patented invention as the making of an electrical log. The statements of **"Facts."** (pp. 5-14 of the petition herein) are in direct opposition to the facts found in the opinion of the Court of Appeals. The District Court herein rendered no opinion discussing or interpreting either of the patents and made no substantial findings of fact [I. 153-9, 163-5]. The Court of Appeals analyzed the disclosures of the respective patents, to determine therefrom the interpretation, meaning and scope of the claims in suit. Such determination rendered it necessary for the Court to make the specific findings reflected in its opinion. The case does not present a situation wherein any finding of fact of the District Court is reversed by the Court of Appeals. The paucity of the District Court's statement of the case [I. 153-5]—even as amended [I. 160-61]—reflects the entire failure of the District Court to consider what is *claimed* as the invention in the respective claims of the patents. The conclusions expressed in the District Court's so-called "Findings of Fact" indicate the misapprehension of the District Court as to what is patented in the respective patents. Neither of the patents claims as the invention the making of an electrical log. The District Court's statement of the case and its findings refer to such logs in such manner as to indicate that the making of such log or logs, and the comparison of such a log of one well with logs of other wells, is the patented invention [*Cf.* Pars. (a) and (b) – I. 156-7].

Question 3.—The alleged disregard by the Court of Appeals of Rule 53a of the Federal Rules of Civil Procedure.

The case presents no "conflict with the accepted and usual course of judicial procedure, as laid down by Rule 53a of the Federal Rules of Civil Procedure and by the decisions of this Court in *Davis v. Schwartz* (1895), 155 U.S. 631, 636; and *Adamson v. Gilliland,* 242 U.S. 350, 353." (Petition, pp. 19-20). The District Court failed to interpret and construe the claims of the patents in suit in accord with the principles of the applicable decisions of this Court. A correct interpretation of such claims and patents, consistent with the applicable decisions of this Court, required the additional findings of the Court of Appeals. To these additional findings of fact, so made by the Court of Appeals, the Court of Appeals applied the principles of patent law established by the applicable decisions of this Court. In so doing, the Court of Appeals followed the precedents established by the decisions of this Court. exemplified in *Honolulu Oil Corp. v. Halliburton,* 306 US 350; *Detrola Radio & Television Corp. v. Hazeltine Corp.,* 313 US 259; *Schriber-Schroth Co. v. Cleveland Trust Co.,* 311 US 211; *Standard Brands v. National Grain Yeast Corp.,* 308 US 34; *Textile Mach. Works v. L. Hirsch Textile Machines, Inc.,* 302 US 490; *General Elec. Co. v. Wabash Appliance Corp.,* 304 US 364; *Exhibit Supply Co. v. Ace Corp.* (decided by this Court Feb. 2, 1942 – 86 L ed Adv. Ops. 453).

The case presents no novel or disputed question of law and no conflict between the principles of law applied by the Court of Appeals and the decisions of this Court. The petition is not based upon any conflict of decision, but merely upon a contention of petitioner that the Court of Appeals erred in its application of established principles of

patent law to the instant facts of the case. Such a contention could be made in any patent case, and cannot be a ground for the grant of a writ of certiorari under the established rules of this Court. We need not therefore extend this brief to show that the Court of Appeal's decision in this case was correct, for this Court is not here concerned with a consideration of the claims in issue of the patents, or of the prior public knowledge referred to by the Court of Appeals in support of its opinion.

We submit there is nothing in this case which justifies the issuance of the writ.

Respectfully submitted,

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